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09/739,023	12/08/2000	Andrea Michalik	2384-002133	4154

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EXAMINER

HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/739,023

Applicant(s)

MICHALIK, ANDREA

Examiner

Wendy C Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Requirement for Information Rule 1.105.

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**DETAILED ACTION****35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the statutory basis for a rejection that may be made at a later date in response to this Examiner's Requirement for Information:

*A person shall be entitled to a patent unless --*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

The claimed *Pelargonium* variety 'PENLAVA' is described in Breeder's Right grant number 7048 published by the **European Community (CPVO)** on June 15, 2001 and filed as application number 19981665 on December 10, 1998, and published February 15, 1999, more than one year prior to the filing date of the instant application. The published application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128.

For example, every two months the CPVO publishes an Official Gazette containing all the information appearing in its Registers, in particular applications for protection, proposals for variety denomination and grants of title. Any other information the CPVO feels the public should be informed about may also be published in the Gazette.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

While the application cited above discloses the claimed plant variety, a question remains as to the reference is enabled. If the plant was publicly available, then the published grant, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant.

The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the Internet and the Office's collection of retail catalogs has revealed no evidence that the claimed plant was publicly available more than one year prior to the filing date of the instant application. However, these references are not comprehensive.

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Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

**OBJECTION TO THE DISCLOSURE**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

*(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

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**More specifically:**

- A. The botanical name of the variety needs to be provided at the front of the specification in its own separate section in order to comply with 37 CFR 1.163(c)(4).
- B. Applicant should set forth the specific parents of the claimed plant, if known, and specify whether or not the parent cultivars are patented.
- C. Applicant should provide the age of the plants as described and the cultural conditions where the plant as described was grown.
- D. Applicant should provide the typical and observed spread of the plant, as described.
- E. Applicant recites: "Response time: 3.5 weeks." It is unclear what this recitation intends to refer to. Correction and/or clarification is required.
- F. Applicant should set forth the length, width, and color (with reference to the employed color chart) of the stems of the claimed plant.
- G. Applicant should provide the width of the leaves of the claimed plant. In addition, applicant should provide a color with reference to the employed color chart for the "weak" leaf zones on the claimed plant, particularly as zonation is not readily apparent in the illustration provided.
- H. Applicant should provide the petiole diameter and strength, as well as the surface texture of same and a color with reference to the employed color chart.
- I. Applicant should set forth the typical and observed number of flowers per inflorescence.
- J. Applicant should provide the petal length and width/diameter. It is unclear which of these measurements the present recitation of "2.0-2.5 cm across" intends to specify. Correction is needed.
- K. Applicant should provide the typical and observed petal shape and petal margin shape for the claimed plant.
- L. Applicant should provide the pistil shape, if known.
- M. Page 3, applicant states "Intense flower color with eye" in the General Characteristics of the claimed plant, however, no eye coloration is noted in the description of flower color and no eye appears in the illustration. Correction and/or clarification is needed. If an eye is present, and additional, close-up illustration of the bloom is needed.
- N. If applicant has any information regarding the heat and/or cold tolerance of the claimed plant, such should be incorporated into the specification.

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The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

***Claim Rejection***

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (703) 308-8898.

The Examiner's is available from 9:30 a.m. to 5:30 p.m., Monday through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

W. C. Haas

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***REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105***

Applicants and/or the assignee(s) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'PENLAVA', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. In the alternative, if applicable, applicant can submit a signed declaration under 37 CFR 1.132 stating that the claimed plant was not publicly available anywhere in the world more than one year prior to the filing date of the instant application for patent.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicants' first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicants are reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicants do not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.



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